

Attorney Docket No. 56765.US/ C-3525.0
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gary H. Knauf

Application No.: 09/978,524

Filing Date: October 16, 2001

Title: METHOD FOR EXTRUSION COATING A LIGHTWEIGHT
WEB

Group Art Unit: 1771

Examiner: Christopher C. Pratt

Confirmation No.: 5048

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RESPONSE

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated September 24, 2003, Applicant submits the following remarks.

In the Office Action, the Examiner issued a requirement that Applicant make an election between the Group I claims (Claims 1-12) and the Group II claims (Claims 13 - 21). Applicant hereby elects Group I (Claim 1-12) but this election is made with traverse and is solely for the purpose of advancing prosecution of this case. It is believed that the requirement to restrict the invention is improper. The claims are sufficiently related that their respective classes would be thoroughly cross-referenced, and many of the same classes would be searched regardless of which group of claims was elected.

The Group I claims are directed to a method of extrusion coating a lightweight web substrate. The Group II claims are directed to coated lightweight web products having reinforcement strips so affixed. Hence both sets of claims require that a search for coated lightweight webs be made.

An examination of the Group II claims will require a search of the same prior art as an examination of the Group I claims. Both would require searching all of the

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art relating to coated webs. Furthermore, separate examination of the Group I and Group II claims may lead to inconsistent examinations and likely will result in duplication of effort. It is therefore a more efficient use of Patent Office manpower and resources to examine all claims which are closely related at one time rather than conducting separate examinations.

The mere fact that one set of claims is directed to a method and the other set is directed to an apparatus does not mean a patent cannot be issued containing both sets of claims. Patents are routinely issued containing method and apparatus or method and product claims.

Moreover, restriction is not "required" by 35 U.S.C. §121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted..." (emphasis added). Likewise, the MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

Because the Examiner has not shown any serious burden if examination of all the claims is conducted and the claims cover closely related subject matter, Applicant respectfully requests the Examiner reconsider and withdraw the restriction requirement and examine Claims 1 - 21.

Respectfully submitted,

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CERTIFICATE OF MAILING

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Assistant Commissioner for Patents, Washington, D.C. 20231

on 10/23/03
Date

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